



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|--------------------------|-------------------------------|------------------------|
| 09/726,009 | 11/29/2000 | Leland James Wieschuegel | AUS9-2000-0738-US1 | 9657 |
| 45993 7590 01/24/2008 IBM CORPORATION (RHF) C/O ROBERT H. FRANTZ P. O. BOX 23324 OKLAHOMA CITY, OK 73123 | | | EXAMINER GRAHAM, CLEMENT B | |
| | | | ART UNIT 3692 | PAPER NUMBER |
| | | | MAIL DATE 01/24/2008 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 09/726,009 | Applicant(s) WIESEHUEGEL ET AL. | |
| | Examiner Clement B. Graham | Art Unit 3692 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-21 remained pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 11, 13, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Applicant's claims are directed to an algorithm. Specifically, claims recites "providing" "querying" "presenting" "preventing", however these steps are mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, for example) and abstract ideas without a practical application are found to be non-statutory subject matter. Therefore, Applicant's claims are non-statutory as they do not produce a useful, concrete and tangible result.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action: (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

4. Claims 1-21, are rejected under 35 U.S.C. 103(a) as being unpatentable over Herman et al (Hereinafter Herman U.S. Pub: 2005/0234811) in view of Goldberg et al (Hereinafter Goldberg U. S. Patent 6, 985, 885).

As per claims 1-6, Herman discloses a sales offering method for restricting access by traders to collected online sealed bids in an online offering and bidding system, said method comprising the steps of:
providing a computer-readable bid repository of collected bids communicative to an

online offering and bidding system, said collected bids each having an associated seal status indication field for indicating whether is bid is a sealed bid or an unsealed bid (see column 14 claim 22 and column 12 para 0178 and para 0176)

querying said bid repository for bids which match parameters of a Broker Profile Matrix associated with a trader and which are indicated as being unsealed bids by said seal status indication field (see para 0176) said trader representing a intermediary third party between a bidder and an offeror;

preventing transfer of sealed bids from said bid repository to a trader responsive to said query (see column 14 claim 22 and column 12 para 0178 and para 0176).

Herman fail to explicitly teach presenting via a computer user interface matching unsealed bids to a trader with whom said Broker Profile Matrix is associated.

However Goldberg discloses The operation of server is controlled primarily by control programs that are executed by the server's CPU. These control programs may be stored in system memory. In a typical implementation, the programs stored in system memory may include: an operating system; a file handling system; a set of user interface procedures, for handling input from user interface and for displaying output to the user on display; one or more application programs; a security module for securely transmitting and receiving data to and from network display, and/or disk drives and ; an auction control module, discussed in more detail below, for managing an online auction, preferably including modules for transmitting information to bidders; receiving bids; evaluating bids to identify winners and losers; making copies of digital content and transmitting those copies to the winning bidders; obtaining and processing payments from the bidders; recording and analyzing bid distributions; allowing the auctioneer to select the auction mechanism to be used; and responding to auctioneer and/or bidder queries regarding the nature of the auction.(see column 6 lines 31-65).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Herman to include presenting via a computer user interface matching unsealed bids to a trader with whom said Broker Profile Matrix is associated taught by Goldberg in order to effect trades of trading

instruments through automatic matching in which buyers and sellers who are willing to trade with each other is based on specified matching criteria.

As per claims 7-12, Herman discloses a computer-readable medium containing program code for a sales offering computer system for restricting access by traders to collected online sealed bids in an online offering and bidding system, said program code when executed by a sales offering computer system causes the sales offering computer system to perform the steps of

of providing a computer-readable bid repository of collected bids communicative to an online offering and bidding system said collected bids indicating whether is bid is a sealed bid or an unsealed bid (see column 14 claim 22 and column 12 para 0178 and para 0176)

and querying said bid repository for bid which match parameters of a Broker Profile Matrix associated with a trader and which are indicated as being unsealed bids by said seal status indication field (see para 0176) said trader representing a intermediary third party between a bidder and an offeror and preventing transfer of sealed bids from said bid repository to a trader responsive to said query (see column 14 claim 22 and column 12 para 0178 and para 0176).

Herman fail to explicitly teach presenting via a computer user interface matching unsealed bids to a trader with whom said Broker Profile Matrix is associated.

However Goldberg discloses The operation of server is controlled primarily by control programs that are executed by the server's CPU. These control programs may be stored in system memory. In a typical implementation, the programs stored in system memory may include: an operating system; a file handling system; a set of user interface procedures, for handling input from user interface and for displaying output to the user on display; one or more application programs; a security module for securely transmitting and receiving data to and from network display, and/or disk drives and ; an auction control module, discussed in more detail below, for managing an online auction, preferably including modules for transmitting information to bidders; receiving bids; evaluating bids to identify winners and losers; making copies of digital content and transmitting those copies to the winning bidders; obtaining and processing payments

from the bidders; recording and analyzing bid distributions; allowing the auctioneer to select the auction mechanism to be used; and responding to auctioneer and/or bidder queries regarding the nature of the auction.(see column 6 lines 31-65).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Herman to include presenting via a computer user interface matching unsealed bids to a trader with whom said Broker Profile Matrix is associated taught by Goldberg in order to effect trades of trading instruments through automatic matching in which buyers and sellers who are willing to trade with each other is based on specified matching criteria.

As per claims 13-21, Herman discloses a sealed bid sales offering system in a computer network, said computer network enabling communications between said sales offering system and trader consoles, said offering system comprising:

a bid database containing collected bids said database being accessible and queriable by sales offering system said collected bids (see column 14 claim 22 and column 12 para 0178 and para 0176)

and a database query server communicative to said bid database indicating whether is bid is a sealed bid or an unsealed bid (see para 0176) and querying said bid repository for bid which match parameters of a Broker Profile Matrix associated with a trader and which are indicated as being unsealed bids by said seal status indication field said trader representing a intermediary third party between a bidder and an offeror and preventing transfer of sealed bids from said bid repository to a trader responsive to said query (see column 14 claim 22 and column 12 para 0178 and para 0176).

Herman fail to explicitly teach presenting via a computer user interface matching unsealed bids to a trader with whom said Broker Profile Matrix is associated.

However Goldberg discloses The operation of server is controlled primarily by control programs that are executed by the server's CPU. These control programs may be stored in system memory. In a typical implementation, the programs stored in system memory may include: an operating system; a file handling system; a set of user interface procedures, for handling input from user interface and for displaying output to the user on display; one or more application programs; a security module for securely

transmitting and receiving data to and from network display, and/or disk drives and ; an auction control module, discussed in more detail below, for managing an online auction, preferably including modules for transmitting information to bidders; receiving bids; evaluating bids to identify winners and losers; making copies of digital content and transmitting those copies to the winning bidders; obtaining and processing payments from the bidders; recording and analyzing bid distributions; allowing the auctioneer to select the auction mechanism to be used; and responding to auctioneer and/or bidder queries regarding the nature of the auction.(see column 6 lines 31-65).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Herman to include presenting via a computer user interface matching unsealed bids to a trader with whom said Broker Profile Matrix is associated taught by Goldberg in order to effect trades of trading instruments through automatic matching in which buyers and sellers who are willing to trade with each other is based on specified matching criteria.

Conclusion

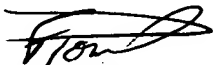
RESPONSE TO ARGUMENTS

5. response to argument's filed May 11/13/07 has been fully considered but they are moot in view of new grounds of rejections.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B Graham whose telephone number is 571-272-6795. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 703-308-0505. The fax phone numbers for the organization where this application or proceeding is assigned are for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.


FRANTZY POINVIL
PRIMARY EXAMINER
AU 3692

Application/Control Number: 09/726,009

Page 7

Art Unit: 3692

CG

JAN 12, 2008